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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

NO. .....

TECHNOGRAPH PRINTED CIRCUITS, LTD., and TECHNOGRAPH PRINTED ELECTRONICS, INCORPORATED, Petitioners,

v.

THE BENDIX CORPORATION, Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Petitioners pray that a writ of certiorari issue to review the Judgment of the United States Court of Appeals for the Fourth Circuit entered in the above entitled case on January 17, 1964.

CITATIONS TO THE OPINIONS BELOW

The opinion of the Court of Appeals is reported at 327 F.2d 497 (1964) and appears in the Appendix to this Petition, *infra*, p. 11.

The opinion of the District Court is reported at 218 F. Supp. 1 (1963). A copy of it appears in Volume I, pages 1a-160a, of the Record as printed for the use of

the court below (copies of that Record have been filed here under the provisions of Paragraph 4 of Rule 21). All of those portions of the District Court's opinion which are believed to be pertinent to the questions here presented appear in the Appendix to this Petition, *infra*, pp. 11-2.

JURISDICTION

The Judgment of the Court of Appeals was entered on January 17, 1964. A rehearing was denied March 18, 1964. Jurisdiction of this Court is invoked under 28 U.S.C. Section 1254(1).

QUESTIONS PRESENTED

(1) Is it arbitrary and violative of the due process clause of the Fifth Amendment for a judge, sitting without a jury in a patent case governed by the provisions of the 1952 Patent Act, to decide, subjectively and in the absence of any proof of the fact, that the subject matter of the patent as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains?

(2) Did Congress, in enacting Sections 103 and 282 of the 1952 Patent Act, establish a statutory criterion of invention and presumption of validity which precludes the courts from holding invalid for lack of patentable novelty a patent whose subject matter is not identically disclosed in the prior art, unless there is substantial objective proof that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains?

CONSTITUTIONAL PROVISIONS INVOLVED

Article I, Section 8:

"The Congress shall have Power * * *

"To Promote the Progress of Science and useful Arts, by securing for Limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; * * *." [U.S.C.A., *Constitution*, 1st Vol., p. 39].

Amendment V:

"No person shall * * * be deprived of * * * property, without due process of law; * * *." [U.S.C.A., *Constitution*, Amdts. 1-5 Vol., p. 297].

STATUTES INVOLVED

35 U.S.C. 101: INVENTIONS PATENTABLE: Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. [35 U.S.C.A., 1st Vol., p. 80].

35 U.S.C. 102: CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT: A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, * * *. [35 U.S.C.A., 1st Vol., p. 81].

Statutes Involved.

35 U.S.C. 103: CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER: A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. [35 U.S.C.A., 1st Vol., p. 81].

35 U.S.C. 282: PRESUMPTION OF VALIDITY; DEFENSES: A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it. [35 U.S.C.A., 1st Vol., p. 102].

STATEMENT OF THE CASE

This is a civil action charging infringement of three patents (one of them a reissue) claiming certain methods of making "printed circuits" or components thereof. Jurisdiction was invoked under 28 U.S.C. 1338 and was admitted in the Answer. The inventions were made in wartime London by Dr. Paul Eisler, an Austrian refugee. Respondent pleaded the usual defenses of invalidity, non-infringement and misuse by reason of the plaintiffs' licensing practices.

The Complaint was filed May 25, 1959; the trial commenced October 2, 1961, and was concluded on December 6, 1961, and the cause was argued and submitted February 5-7, 1962. More than fifteen months later, on May 27, 1963, the trial judge filed an opinion sustaining all of the defenses and on June 6, 1963, entered judgment of dismissal accordingly. Notice of appeal was filed on the same day.

The trial judge entered no separate findings of fact. In his opinion he primarily held the claims in suit invalid because of "anticipation" (35 U.S.C. 102) by an earlier-filed application of Stevens & Dallas, but added (71a):

> "Should another court find that the alleged Eisler inventions were not identically disclosed or described in the Stevens and Dallas application, this court unhesitatingly finds and holds that 'the differences between the subject matter sought to be patented and the prior art' were 'such that the subject matter as a whole would have been obvious at the time the [alleged] invention[s] [were] made to a person having ordinary skill in the art to which said

subject matter pertains' (35 U.S.C. 103). The court holds that the Stevens and Dallas application — not considered by the Examiner — of itself invalidates the Eisler patents, either as an anticipation, or as showing lack of novelty.

"Even apart from the Stevens and Dallas application the court holds that the other prior art, cited and uncited by the Examiner conclusively shows lack of novelty."

Petitioners appealed. The Court of Appeals evidently agreed with petitioners that there was no anticipation, because it affirmed the trial court on the *sole* ground of "obviousness in the light of the prior art for the reasons fully discussed in the opinion of the District Court".

The "reasons" stated in the opinion of the District Court (collected *infra*, pp. 11-2) are subjective ones; there was no *proof* whatsoever that the subject matter as a whole of any patent in suit "would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Stated most favorably for respondent, the *evidence* shows no more than that something *less* than the whole subject matter of any patent was perceived by a few persons of far *more* than ordinary skill in the art, and not at the time the Eisler inventions were made but at a later date or dates.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT

(1) The Questions Presented are fundamental ones in patent law which have not been but should be decided by this Court:

The Constitutional standard is that patents shall be granted only for inventions. A patent which falls short of the Constitutional standard should be held invalid but public faith demands that a patent which does meet the standard should be upheld; the constitutional purpose, which is "to promote the progress of science and useful arts", is just as much defeated by the courts when they hold a good patent invalid as when they hold a bad patent valid; *Grant et al. v. Raymond,* 6 Peters 218, 241-2 (1832).

It was settled by this Court in the year 1850 that mere novelty is not enough to sustain a patent; that there must be a difference representing more "ingenuity and skill" than that possessed by "an ordinary mechanic acquainted with the business"; *Hotchkiss v. Greenwood,* 52 U.S. 615 (1850). As far as we are aware, neither this Court nor any other Court of the United States has formulated any minimum requirements for *proof* of invention (or lack of it) in a century of decisions following *Hotchkiss v. Greenwood.* Nor did Congress undertake to formulate an authoritative standard. The result was that decisions came to be "based upon the idiosyncrasies of a merely personal judgment"; cf. *Leland v. Oregon,* 343 U.S. 790, 799 (1952); sometimes resulting in deep divisions within the courts themselves; see, e.g., *Jungersen v. Ostby & Barton Co.,* 335 U.S. 560 (1949).

Reasons for Allowance of Writ.

In the year 1949 Congress undertook a complete study of the patent laws, resulting in the enactment, in 1952, of the present Patent Act (35 U.S.C.A., 1st Vol., p. 6). Two of its provisions are important here:

(i) Section 282 made it statutory that a patent shall be presumed valid by the courts and that the burden of establishing invalidity shall rest on a party asserting it. This presumption and the burden it entails are entirely fair and comport with due process; *Leland v. Oregon, supra;* because they have a rational connection with the ultimate fact to be proven, in that the 1952 Act, like its predecessors, provides elaborate machinery for insuring that no patent shall issue until after it has been rigorously examined in the Patent Office by technically skilled examiners; 35 U.S.C. §§ 111-135.

(ii) Section 103 provided the first statutory yardstick for measuring the inventive quality of an improvement in the useful arts. The Committee Report describes this as one of the two "major changes or innovations" in our patent law, says that the section is added to the statute "for uniformity and definiteness" and says that it "should have a stabilizing effect and minimize great departures which have appeared in some cases" (35 U.S.C.A., 1st Vol., pp. 20, 21); cf. *Aro Mfg. Co. v. Convertible Top Co.*, —— U.S. ——, Law Week, June 9, 1964, 4459, 4463-4.

In opinions written since the 1952 enactment, various of the Courts of Appeals have considered the question whether "invention" is an issue of fact or of law, the most recent case being *Monroe Auto Equipment Co. v. Heckethorn Mfg. Co.*, (C.A. 6, decided May 14, 1964) 141 USPQ 549, not yet officially reported. That case holds, consistent with the concurring opinion of Mr. Justice Black in *Graver Mfg. Co. v. Linde Co.*, 336 U.S. 271,

280-1 (1949) that the *ultimate* question of patentability cannot properly be classified as a finding of fact, but is a question of law.

The *Monroe* decision emphasizes, however, that there must be *a factual basis* for the decision of the ultimate question, and holds invalid the patent there involved on a record which included testimony that "it would have been obvious" to borrow the characterizing feature of the claim from another art in which that feature had been used in the same way. In a case decided four days later, however; *Bain v. The M. A. Hanna Company*, 141 USPQ 559, not yet officially reported; the same Court rejected a similar finding by the trial court, saying (p. 562):

> "We have concluded that the Trial Court's finding of lack of invention is not warranted by this record. There is no evidence that the alleged invention described in Claims 1, 2 and 3, from the entire prior art would be obvious to one skilled in the art. The record simply does not contain any factual basis for such finding and conclusion."

In the instant case, as in the *Bain* case, there is simply no factual basis for a finding and conclusion that the claimed invention "from the entire prior art, would be obvious to one skilled in the art" at the time the Eisler inventions were made; *supra*, p. 6.

These decisions in the Sixth Circuit comport with petitioners' contention that by enacting Sections 282 and 103 Congress defined "the limits of accepted notions of justice" in this area; *Leland v. Oregon, supra;* and mandated that a patent may not be held invalid for lack of invention except on the basis of satisfying *proof* that

"the subject as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains" and that a finding of invalidity may no longer be "based upon the idiosyncrasies of a merely personal judgment", as was the finding in this case.

(2) A patent is property and its owner is entitled to the protection of the Fifth Amendment; *Cramp & Sons v. Curtis Turbine Co.*, 246 U.S. 28, 39-40 (1918). Petitioners therefore submit that a decision of invalidity which does not observe but to the contrary flouts the *ratio decidendi* mandated by Sec. 103 violates due process.

(3) Since the Court of Appeals decided this case on the *sole* ground of lack of patentable novelty under Section 103, the questions posed by the petition are squarely presented. Although the 1952 Patent Act is now twelve years old, this Court has never decided any case arising under Sections 282 and 103. The last decision by the Court on the question of "invention" is *A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147, decided December 4, 1950. The hope of Congress, that "great departures which have appeared in some cases" would be minimized by the enactment of Section 103, bid fair to remain unrealized until this Court speaks.

Respectfully submitted,

JOHN W. AVIRETT, 2d.
WALTER J. BLENKO
WALTER J. BLENKO, JR.

June 12, 1964

APPENDIX

Opinion of the Court of Appeals

(Caption Omitted)

Filed January 17, 1964

PER CURIAM:

After careful consideration of the record, the arguments and the briefs of counsel, we are persuaded that the patent claims are invalid for obviousness in the light of the prior art for the reasons fully discussed in the opinion of the District Court. Technograph Printed Circuits, Ltd. v. Bendix Aviation Corp., D.C. Md., 218 F. Supp. 1.

Affirmed.

Portions of Opinion of the District Court

(Caption Omitted)

Filed May 27, 1963

[The opinion of the District Court appears in full in Petitioners' appendix in the Court of Appeals, Volume I, pages 1a-160a]

* * * * * * *

The Prior Art.

The most significant single reference in the prior art, from the viewpoint of the court, and apparently from that of the parties to this suit[110] is Application Serial No. 184,419, of Stevens and Dallas, filed January 11, 1938,[111] (not cited of record in the prosecution of any of the patents in suit) and incorporated by reference in Stevens and Dallas Patent No. 2,219,497[112] issued on October 29, 1940. It is urged by defendant both as

anticipation (35 U.S.C. 102) and as evidence of non-invention (35 U.S.C. 103). [p. 57a Appendix]

* * * * * * *

Should another court find that the alleged Eisler inventions were not identically disclosed or described in the Stevens and Dallas application, this court unhesitatingly finds and holds that "the differences between the subject matter sought to be patented and the prior art" were "such that the subject matter as a whole would have been obvious at the time the [alleged] invention[s] [were] made to a person having ordinary skill in the art to which said subject matter pertains" (35 U.S.C. 103). The court holds that the Stevens and Dallas application—not considered by the Examiner—of itself invalidates the Eisler patents, either as an anticipation, or as showing lack of novelty. [p. 71a Appendix]

* * * * * * *

* * * from the prior art the court was then convinced[19] that the mere production of copper lines, which by their very nature were necessarily electrically conductive, by printing and etching did not disclose patentable novelty over the prior art. [p. 97a Appendix]

* * * * * * *

Judgment of the Court of Appeals

(Caption Omitted)

Filed January 17, 1964

THIS CAUSE came on to be heard on the record from the United States District Court for the District of Maryland, and was argued by counsel.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court appealed from, in this cause, be, and the same is hereby, affirmed with costs.

Office Supreme Court, U.S.
FILED
JUL 13 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM 1963

No. [redacted] 176

TECHNOGRAPH PRINTED CIRCUITS, LTD., and TECHNOGRAPH PRINTED ELECTRONICS, INCORPORATED,
Petitioners,

v.

THE BENDIX CORPORATION, *Respondent.*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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IN THE

Supreme Court of the United States

OCTOBER TERM 1963

No. 1211

TECHNOGRAPH PRINTED CIRCUITS, LTD., and TECHNOGRAPH PRINTED ELECTRONICS, INCORPORATED,
Petitioners,

v.

THE BENDIX CORPORATION, *Respondent.*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

---

BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the District Court is reported at 218 F. Supp. 1 (1963) and is reproduced in Volume I, pages 1a-160a of the Appendix to Petitioner's Brief in the Court below (I: 1a-160a). The *per curiam* affirming opinion of the Court below is reported at 327 F. 2d 497 (1964) and appears in the Appendix to the Petition.

JURISDICTION

The jurisdictional requisites are adequately set forth in the Petition.

QUESTION PRESENTED

Whether this petitioner can obtain a *second** review of a baseless argument rejected by the Court below merely by

(1) appending to that selfsame argument a reference to the due process clause of the Fifth Amendment, and

(2) conveniently ignoring in the Petition the mass of *objective* evidence before the Court below, fully supporting the holding that the claims in suit are invalid as obvious.

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

The constitutional provisions and statutes both *actually* involved and *assertedly* involved are set forth at pages 3-4 of the Petition.

STATEMENT OF THE CASE

Petitioners sued respondent for infringment of certain claims of three Eisler patents, all of which stem from a single original application. All claims of the patents in suit recite *methods* for manufacturing "printed circuits". In his specifications, Eisler necessarily acknowledged that the method steps recited were known to and borrowed from the graphic arts. (I: 185a, col. 1, line 50 to col. 2, line 15)

---

* Emphasis added unless otherwise indicated.

After an extensive trial, during which the District Court heard the evidence of twenty-seven witnesses and received twenty depositions of additional witnesses, judgment was rendered for respondent. The District Court's decision was *not* solely (or even "primarily") based on anticipation of the claims by the Stevens and Dallas application as asserted by petitioners, but on *each* of the following grounds:

> (1) all of the asserted claims of Eisler patent 2,441,960 and claim 5 of Eisler patent 2,706,697 are invalid because they define inoperative procedures;
>
> (2) Eisler reissue patent 24,165 is invalid for double patenting over the '960 patent;
>
> (3) the claims in suit are invalid as anticipated by the prior art;
>
> (4) the claims in suit are invalid as defining subject matter which is obvious in view of the prior art;
>
> (5) the indefiniteness of many of the claims in suit which supported the finding of invalidity; and
>
> (6) none of the involved claims was infringed by defendant.

The District Court's findings of invalidity were based on:

> (1) a detailed consideration of the prosecution histories of the applications maturing into the patents in suit, including the disclosure of each of 15 different prior patents cited by the Patent Office. (I: 14a-52a);

(2) a detailed consideration of some 15 additional prior patents and other prior art *not cited* by the Patent Office against the Eisler applications and found by the Court *to be more pertinent* than the cited art (I: 57a-88a). This consideration included the detailed testimony of defendant's expert witness (Vol. 1, pp. 157-178 of Appendix to Brief of Defendant in the Court below*) comparing the methods advanced as invention by Eisler to the methods described in the prior art references;

(3) the testimony of various witnesses as to the commercial use and practicality of the methods disclosed by the prior patents (I: 63a-64a, 74a, 83a);

(4) a thorough analysis of the testimony of witnesses of both parties and copious printed evidence concerning the meaning of the critical terms of the claims in suit (I: 88a-101a);

(5) testimony of various *independent* developers of the same methods recited by the claims of the patents in suit, each of whom testified that, when faced with a need for printed circuitry, he too independently "borrowed" the hallowed techniques of the graphic arts (I: 121a-122a, 131a-132a); and

(6) testimony of the Director of Research of a pioneer and leading supplier of the raw material *essential* to the claimed methods (a metal-coated insulating material) that the commercial success of the processes used by defendant is attributable to the development of a satisfactory raw material rather than to any disclosure of Eisler (I: 121a-122a).

---

* Hereinafter cited as (D-I: —).

In the Court of Appeals, petitioner advanced various Fourth Circuit decisions espousing the "objective test" of invention and argued, as here, that

> "Defendant has the burden of *proving* invalidity; 35 U.S.C. 282; but its brief cites no *evidence* which proves, or even tends to prove, that the subject matter of any claim in suit, taken as a whole, was obvious in 1943 to a person of ordinary skill in the art." [Emphasis by petitioners.] (Petitioners' Reply Brief, pp. 20, 21)

But respondent's (defendant's) brief *did* delineate the objective evidence of obviousness with which the record is replete. Significantly, the Court of Appeals for the Fourth Circuit, long a proponent of the objective test of invention, held:

> "After careful consideration of the record, the arguments and the briefs of counsel, we are persuaded that the patent claims are invalid for obviousness in the light of the prior art for the reasons fully discussed in the opinion of the District Court."

ARGUMENT

I.

The "Questions Presented" Are Not Raised by the Record

The "questions presented" by the Petition are based solely on petitioners' specious assertion that the record in this case is devoid of proof of the obviousness of the subject matter of the claims in suit. Rather than to belabor all of the objective evidence present in the record upon which the decision of the Courts below was soundly based, representative samples will be presented.

Initially, the record contains the detailed testimony of defendant's expert in which the disclosures of the

cited references were explained to the District Court and the marked similarity, and in many cases the identity, of teaching between such references and the claimed invention was pointed out. For example, and in the words of the District Court:

> "When asked to compare these processes [disclosed by Stevens and Dallas] with Basist or Kaufman, defendant's expert without objection replied that they are the same. Asked to compare them with the printing and etching steps found in '960, he again replied, without objection:
>
> > 'They are the same. However, Stevens and Dallas go into more detail and are more complete in the description of the etching process and in the resist application techniques.'
>
> With this appraisal, the court unqualifiedly agrees." (I:63a)

With respect to the O'Connell reference, defendant's expert testified:

> "Q. Now, again comparing processes, what distinction if any do you find between the process set forth which you have read into the record, which appears as the bridging paragraph of the two columns on page 2 of O'Connell, and the process steps set forth in Eisler specification '960 with respect to printing and etching to produce electric components?
>
> "A. They are the same. The sequence of steps, the etching away all of the metal through to the substrate, and, in particular, going down to line 15 of column 2, on page 2, 'This device appears to be also useful as a substitute for the usual aerial or antenna,' and the coil, No. 31, in figure 7, of the Eisler specification, as I remember it, is said to be usable in the antenna circuit of that radio. So, we are in the same field of endeavor with an identical process." (D-I: 166)

Any more objective proof of obviousness than such testimony would be hard to imagine. In addition to the expert testimony with respect to the O'Connell patent, Shortt, the president of the American plaintiff, *admitted the obviousness* of the claimed printing and etching technique of Eisler in view of O'Connell's teaching. The following testimony is significant:

> "Q. Would the knowledge of how Defendant's Exhibit 317 [the electrostatic shield or antenna disclosed by O'Connell] is made suggest anything to you about how to make Defendant's Exhibit 319 [the inductance coil made during *inter partes* tests by the Eisler process]?
>
> "A. If someone had told me and showed me that pattern and told me—
>
> "Q. By that pattern do you mean Defendant's Exhibit 317?
>
> "A. Yes.
>
> "Q. All right.
>
> "A. —had been made from a foil clad laminate, had been printed and etched, then I would say there was no reason why you couldn't make that [indicating Defendant's Exhibit 319] by the same process.
>
> "Q. And by that you mean Defendant's Exhibit 319 for identification?
>
> "A. That's right." (D-I: 57)

Witness after witness testified that when a need to produce printed circuitry arose, each, without any knowledge of Eisler, turned to the known graphic arts techniques and were successful in their endeavors. For example, Swiggett, petitioners' primary technical witness, testified on cross-examination:

> "Q. Now isn't it a fact, Mr. Swiggett, that when you took these samples into your laboratory, you just performed the well-known process of plating [printing] and etching which you knew all about?
>
> "A. Yes." (D-I: 7)

Pritikin testified that when first exposed to the problem of producing printed circuitry, he immediately turned to the printing and etching techniques with which he was familiar as the *"obvious"* way of proceeding. (D-I: 94)

It was on the basis of such *objective evidence of obviousness* that the lower Court stated:

> "When the available literature, both patents and publications, not cited, is considered, and also the ability of persons unaware of the alleged inventions to reach the same results by the same means, the court has no hesitation in holding the patents, and the claims in suit, to be invalid." (I: 54a).

For petitioners to urge, on the basis of the record in this case, that the Courts below reached their decisions without the aid of evidence of obviousness is simply incomprehensible. The "questions presented" by petitioners are wholly synthetic—they can not find support in the record of this case.

II.

The Authorities Relied on by Petitioners Do Not Justify the Review Sought

In addition to quoting from and repeatedly citing a decision of this Court refusing to strike down a State statute requiring that a defendant in a criminal case prove a defense of insanity beyond a reasonable doubt (*Leland* v. *Oregon*, 343 U.S. 790 (1952)), petitioners

appear to rely primarily on *Monroe Auto Equipment Co.* v. *Heckethorn Mfg. Co.*, — F. 2d —, 141 USPQ 549 (6th Cir. 1964), and *Bain* v. *The M. A. Hanna Company*, 331 F. 2d 974, (6th Cir. 1964).

Reliance on *Monroe* is based on a statement in the opinion:

> "There was testimony that it would have been obvious to insert a rubber sleeve to prevent the metal-to-metal contact and resultant noise of the spring banging against the shock absorber." (141 USPQ 555)

The implication petitioners seek to draw is that there must be express *testimony* that the claimed invention is obvious, as opposed to *evidence of obviousness*, before a court properly may hold a claim invalid as obvious under 35 U.S.C. 103. But the Court in *Monroe* belies this implication at 141 USPQ 554, stating:

> "Thus what we have in a patent case are three steps: First, a determination of what the prior art was; this involves factual questions. Secondly, there is a determination of what, if any, improvement the patentee has made over the prior art; this will usually turn on expert testimony and therefore is a question of fact. The final step is to determine whether the improvement would have been obvious to one skilled in the art. This requires application of a legal criteria and therefore *is a question of law, fully reviewable by* the appellate court."

Moreover, at 141 USPQ 558 the Court expressly held that claim 14 of patent '235 was invalid for lack of invention over the disclosure of four patents and an S.A.E. Journal article.

Manifestly, the Court of Appeals for the Sixth Circuit did not require *express* testimony of obviousness

in the teeth of its prior decision in *General Motors Corp.* v. *Estate Stove Co.*, 203 F. 2d 912 (6th Cir. 1953), on a petition for rehearing advancing essentially the same argument made by petitioners here. There the court stated:

> "In advancing its argument, appellee submits, at least implicitly, that, under the new Act, the evidence establishing invalidity must consist of the testimony of witnesses, and that the court's finding of invalidity must be sustained by such testimonial evidence. *We find no warrant in the Act for such a conclusion, nor that the function of the court has changed in this regard* since Judge Learned Hand made a memorable declaration in the field of patent law, in Kohn v. Eimer, 265 F. 900, 902 (C.C.A. 2), when he stated: 'At the outset the appellant challenges our right to examine the prior art patents at all, because the appellee called no expert at the trial to explain them. Waterman v. Shipman, 55 F. 982, 987; 5 C.C.A. 371. We have not the slightest wish to minimize the vital importance of expert testimony in patent suits, or to suggest that we are not absolutely dependent upon it within its proper scope; but that scope is often altogether misapprehended, as the appellant has misapprehended it here. Specifications are written to those skilled in the art, among whom judges are not. It therefore becomes necessary, when the terminology of the art is not comprehensible to a lay person, that so much of it as is used in the specifications should be translated into colloquial language; in short, that the judge should understand what the specifications say. This is the only permissible use of expert testimony which we recognize. When the judge has understood the specifications, he cannot avoid the responsibility of deciding himself all questions of infringement and anticipation, and the testimony of experts upon these issues is in-

evitably a burdensome impertinence.'" (203 F. 2d 914-915.)

The same position was more recently taken by the Court of Appeals for the same Sixth Circuit in *Nickerson* v. *Bearfoot Sole Company*, 311 F. 2d 858, 869, 870 (6th Cir. 1963).

Clearly, the Court in *Monroe* was merely requiring that the status of the prior art be determined preliminary to finding whether a patentable advance (if any) over the prior art had been made. The present case is replete with evidence both of the status of the prior art and of the lack of patentable improvement over that prior art.

In *Bain* v. *M. A. Hanna Co., supra,* the Court of Appeals affirmed the holding of the District Court that the patent in suit was *anticipated* and, accordingly, invalid. The court then declined to affirm the holding of *lack of invention* on grounds that "the record does not contain any factual basis for such finding and conclusion." The deficiency of the record in this regard was not delineated. Even if it logically can be accepted that an anticipatory reference under 35 U.S.C. 102 is not also evidence of obviousness under 35 U.S.C. 103, a "factual basis" for a holding of obviousness clearly is presented by the present record.

It is manifest that if the present Petition were granted, it would be the *sufficiency* of the evidence of obviousness *in this case* which would be reviewed, and not the abstract requirement of 35 U.S.C. 103, as urged by petitioners.

III.

There is no Legitimate Issue of Due Process Raised by This Petition

The record in this case provides overwhelming evidence of the obviousness of the claims in suit. Accordingly, the affirmance of the holding of invalidity on that ground was amply justified. Since 35 U.S.C. 103 clearly is satisfied, due process has been observed.

CONCLUSION

In *Magnum Import Co.* v. *DeSpoturno Coty*, 262 U.S. 159, 163 (1922), Chief Justice Taft stated:

> "The jurisdiction [by certiorari] was not conferred upon this court merely to give the defeated party in the circuit court of appeals another hearing."

"Another hearing" would be the only result of the granting of the Petition in this case.

The Petition should be denied.

Respectfully submitted,

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

NO. 176

TECHNOGRAPH PRINTED CIRCUITS, LTD., and TECHNOGRAPH PRINTED ELECTRONICS, INCORPORATED, Petitioners,

v.

THE BENDIX CORPORATION, Respondent.

REPLY BRIEF FOR PETITIONERS

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REPLY BRIEF FOR PETITIONERS

(1) Contrary to respondent's assertion, the questions presented by the Petition *are* raised by the record; the quotation (Respdt's. Br. p. 5) from petitioners' brief in the Court of Appeals sufficiently shows this. And respondent's own argument (Respdt's. Br. 8-11) emphasizes the need for a definitive ruling by this Court.

Moreover, the Questions Presented challenge the *ratio decidendi* of the Court of Appeals in its entirety. Petitioners demonstrated below, by detailed analyses of the claims in suit, that none of them, *taken as a whole,* was "identically disclosed or described as set forth in Section 102 of [Title 35]," and the Court of Appeals bottomed its decision on Section 103 alone.

(2) Petitioners do not suggest for a moment that a patent may not be held invalid even though the defendant fails to make proof of the matters stated in Section 103; they recognize that a claim may be unpatentable even if its subject matter as a whole was not obvious to a person of ordinary skill in the art; for example, it might be

fatally lacking in the attainment of any new result; cf. *Armour & Co. v. Wilson & Co.*, (C.A. 7, 1960) 274 F.2d 143, 151 *et seq.* The Court of Appeals, however, found no such infirmities in any of the claims in suit.

The root question here is whether, after Congress defined and delimited the issue of "obviousness" in Section 103, the courts may ignore the mandate of Congress and decide the question of obviousness by other standards. The intent of Congress, by the enactment of Section 103, to outlaw merely personal judgments and fix a *statutory* standard, is as clear and certain as was its intent, by the enactment of Section 271(c), to affirm the doctrine of contributory infringement as it existed before the *Mercoid* case; cf. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 32 LW 4459, 4462, fn. 6; Petition, pp. 7-8. It is equally clear that in enacting Section 282 Congress mandated proof of *every* requirement of Section 103 in order to overcome the presumption of validity attaching to the grant, a presumption which becomes increasingly necessary in the administration of the patent law with the increasing complexities of modern technology; *Williams Mfg. Co. v. United Shoe Machy. Corp.*, (C.A. 6, 1941) 121 F.2d 273, 277; aff'd. 316 U.S. 364 (1942).

(3) If petitioners are right in their contention, they were plainly denied due process in the lower courts because the record is devoid of *any* proof, testimonial or documentary, that the subject matter of any claim in suit was obvious (i) as a whole (ii) in 1943 (iii) to a person having ordinary skill in the electrical circuit art.

The claims are not for the production of "printed circuitry" broadly (cf. Respdt's. Br. pp. 7-8) but for combinations, defined in detail in the claims, the use of which lead to the attainment of new results, or old results in a more facile or economical way. Subject matter of that sort may be patented even though *all* of the steps or elements are severally old. The evidence referred to in respondent's brief does not go to the subject matter of *any* claim as a whole, but only to a step or steps constituting less than the entirety of any claim; steps, moreover, which were known by the Patent Office Examiners to be old when the Eisler applications were before them. Evidence of that sort shows merely (i) that something *less* than the whole subject matter was perceived (ii) at a date after the Eisler inventions were made (iii) by a few persons having far *more* than the ordinary skill of the art. That is not the evidence mandated by Section 103.

The petition should be granted.

Respectfully submitted,

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July 22, 1964.